UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,832	09/12/2001	Travis J. Parry	10013769-1	8146

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EXAMINER
BAUGH, APRIL L

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Office Action Summary	Application No.	Applicant(s)
		09/954,832	PARRY ET AL.
		Examiner	Art Unit
		April L Baugh	2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 September 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date *20030421&20040224*.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

2.   Claims 1-5, 8, 11, 16-18 rejected under 35 U.S.C. 102(b) as being unpatentable by US

Patent 4,928,252 to Gabbe et al.

Regarding claim 1 and 8, Gabbe et al. teaches a method and system for facilitating

generation of a hard copy, comprising the steps of: selecting a document file written in a first

language (column 4, lines 52-53 and column 5, lines 10-14); selecting a translator configured to

translate the document file into a second language (column 5, lines 21-22); and packaging the

document file and the translator together in a job package that can be received by a hard copy

generation device (column 4, lines 40-44 and column 5,lines 35-45 and 47-50).

Regarding claim 11 and 18, Gabbe et al. teaches a method and system for generating a

hard copy, comprising the steps of: receiving a job package comprising a document file

representing a document, the document file written in a first language, and a translator

configured to translate the document file into a second language (column 4, lines 52-53 and

column 5, lines 10-14 and 21-22); opening the job package; using the translator to translate the

document file into the second language; and generating a hard copy of the document (column 4,

lines 40-44 and column 5,lines 35-45 and 47-50).

Regarding claim 2, Gabbe et al. teaches the method of claim 1, wherein the step of selecting a document file comprises selecting a document file identified by a user (column 4, lines 52-53 and column 5, lines 10-14).

Regarding claim 3, Gabbe et al. teaches the method of claim 1, wherein the step of selecting a translator comprises selecting a translator identified by a user (column 5, lines 21-22).

Regarding claim 4, Gabbe et al. teaches the method of claim 1, further comprising the step of transmitting the job package to the hard copy generation device (column 4, lines 40-44 and column 5,lines 35-45 and 47-50).

Regarding claim 5, Gabbe et al. teaches the method of claim 1, further comprising the step of transmitting the job package to a recipient computing device (column 4, lines 40-44 and column 5,lines 35-45 and 47-50).

Regarding claim 16, Gabbe et al. teaches the method of claim 11, further comprising the step of registering with a remote computing device prior to generating the hard copy (column 4, lines 40-44).

Regarding claim 17, Gabbe et al. teaches the method of claim 16, wherein the step of generating a hard copy is enabled by the remote computing device (column 4, lines 40-44 and column 5,lines 35-45 and 47-50).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 6, 9, 12-14, and 19-20 rejected under 35 U.S.C. 103(a) as being unpatentable over

US Patent 4,928,252 to Gabbe et al. in view of Dathathraya (US 2003/0044009).

Regarding claims 6 and 9, Gabbe et al. teaches the method of claim 1 and 8 (column

5,lines 35-45 and 47-50).

Gabbe et al. does not teach encrypting the job package. Dathathraya teaches further

comprising the step of encrypting the job package (page 1, section 0010 and page 2, section 0022

and page 3, section 0035). Therefore it would have been obvious to one of ordinary skill in the

art at the time the invention was made to further modify the hard copy generation system of

Gabbe et al. by encrypting the job package because this secures the transmission of sensitive

and/or copyrighted documents.

Regarding claim 12, Gabbe et al. teaches the method of claim 11 (column 5,lines 35-45

and 47-50).

Gabbe et al. does not teach receiving an encrypted job package. Dathathraya teaches

wherein the step of receiving a job package comprises receiving an encrypted job package (page

1, section 0010 and page 2, section 0022 and page 3, section 0035). Therefore it would have

been obvious to one of ordinary skill in the art at the time the invention was made to further

modify the hard copy generation system of Gabbe et al. by receiving an encrypted job package

because this secures the transmission of sensitive and/or copyrighted documents.

Regarding claims 13 and 19, Gabbe et al. teaches the method of claim 12 and 18 (column

5,lines 35-45 and 47-50).

Gabbe et al. does not teach decrypting the job package prior to opening it. Dathathraya

teaches further comprising the step of decrypting the job package prior to opening it (page 1,

section 0010-0011 and page 2, section 0025). Therefore it would have been obvious to one of

ordinary skill in the art at the time the invention was made to further modify the hard copy

generation system of Gabbe et al. by decrypting the job package prior to opening it because this

secures and controls the reproduction of sensitive and/or copyrighted documents.

Regarding claims 14 and 20, Gabbe et al. teaches the method of claim 13 and 19 (column

5,lines 35-45 and 47-50).

Gabbe et al. does not teach retrieving a decryption key. Dathathraya teaches further

comprising the step of retrieving a decryption key prior to the step of decrypting the job package

(page 1, section 0010-0011 and page 2, section 0025 and page 3, section 0035). Therefore it

would have been obvious to one of ordinary skill in the art at the time the invention was made to

further modify the hard copy generation system of Gabbe et al. by retrieving a decryption key

because this secures and controls the reproduction of sensitive and/or copyrighted documents.

5.   Claims 7, 10, and 15 rejected under 35 U.S.C. 103(a) as being unpatentable over US

Patent 4,928,252 to Gabbe et al. in view of Dathathraya (US 2003/0044009) as applied to claims

6, 9, 12-14, and 19-20 above, and further in view of Strobel et al. (US 6,751,732).

Regarding claims 7 and 10, Gabbe et al. teaches the method of claim 1 and 8 (column

5,lines 35-45 and 47-50).

Gabbe et al. does not teach a decryption key that can be used to decrypt the job package.

Dathathraya teaches a decryption key that can be used to decrypt the job package (page 1,

section 0010-0011 and page 2, section 0025 and page 3, section 0035) and keys can be

maintained at websites (page 2, section 0023). Therefore it would have been obvious to one of

ordinary skill in the art at the time the invention was made to further modify the hard copy

generation system of Gabbe et al. by having a decryption key that can be used to decrypt the job

package because this secures and controls the reproduction of sensitive and/or copyrighted

documents.

Gabbe et al. in view of Dathathraya does not teach further comprising the step of

appending an address to the job package that identifies the location of a decryption key. Strobel

et al. teaches further comprising the step of appending an address to the job package that

identifies the location of a decryption key (column 2, lines 45-64 and column 10, line 32-62

Since Dathathraya teaches that the key can be located a website, then the pointer utilized in

Strobel to locate the document on a server can just as well be used to locate a key on a

server/website instead). Therefore it would have been obvious to one of ordinary skill in the art

at the time the invention was made to further modify the hard copy generation system of Gabbe

et al. in view of Dathathraya by further comprising the step of appending an address to the job

package that identifies the location of a decryption key because this allows the key to be

accessible by multiple printers.

Regarding claim 15, Gabbe et al. in view of Dathathraya teaches the method of claim 14,

and the step of retrieving a decryption key (page 1, section 0010-0011 and page 2, section 0025

and page 3, section 0035) and keys can be maintained at websites (page 2, section 0023 of

Dathathraya).

Gabbe et al. in view of Dathathraya does not teach retrieving the key via a network using an address appended to the job package. Strobel et al. teaches retrieving the key via a network using an address appended to the job package (column 2, lines 45-64 and column 10, line 32-62 Since Dathathraya teaches that the key can be located a website, then the pointer utilized in Strobel to locate the document on a server can just as well be used to locate a key on a server/website instead). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the hard copy generation system of Gabbe et al. in view of Dathathraya by retrieving the key via a network using an address appended to the job package because this allows the key to be accessible by multiple printers.

6.   Claims 21-25 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,928,252 to Gabbe et al. in view of Strobel et al. (US 6,751,732).

Regarding claims 21 and 24, Gabbe et al. teaches a method and system for generating a hard copy, comprising the steps of: a job package that comprises a document file representative of a document, the document file written in a first language (column 4, lines 52-53 and column 5, lines 10-14) and a translator configured to translate the document file into a second language (column 5, lines 21-22); retrieving the job package; opening the package; using the translator to translate the document tile into the second language; and generating a hard copy of the document (column 4, lines 40-44 and column 5,lines 35-45 and 47-50).

Gabbe et al. does not teach receiving an address that identifies the location of a job package. Strobel et al. teaches receiving an address that identifies the location of a job package (column 2, lines 45-64 and column 10, line 32-62). Therefore it would have been obvious to one

of ordinary skill in the art at the time the invention was made to further modify the hard copy

generation system of Gabbe et al. by receiving an address that identifies the location of a job

package because this allows the document and translator to be accessible by multiple printers.

Regarding claims 22 and 25, Gabbe et al. teaches the method of claim 21 and 24 (column

5,lines 35-45 and 47-50).

Gabbe et al. does not teach retrieving the package from a remote location via a network.

Strobel et al. teaches wherein the step of retrieving the job package comprises retrieving the

package from a remote location via a network (column 2, lines 45-64 and column 10, line 32-

62). Therefore it would have been obvious to one of ordinary skill in the art at the time the

invention was made to further modify the hard copy generation system of Gabbe et al. by

retrieving the package from a remote location via a network because this allows the document

and translator to be accessible by multiple remote and local printers.

Regarding claims 23, Gabbe et al. teaches the method of claim 21 (column 5,lines 35-45

and 47-50).

Gabbe et al. does not teach receiving a one-time use address. Strobel et al. teaches

wherein the step of receiving an address comprises receiving a one-time use address (column 2,

lines 45-64 and column 10, line 32-62). Therefore it would have been obvious to one of ordinary

skill in the art at the time the invention was made to further modify the hard copy generation

system of Gabbe et al. by receiving a one-time use address because this allows control of

document reproduction by only allowing the document to be accessed once for reproduction.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with respect to facilitating generation of hard copies: Wiegley, DeBry, Teshigawara, Gassho, Tomida et al., Shima, Schacht et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April L Baugh whose telephone number is 571-272-3877. The examiner can normally be reached on Monday-Friday 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALB

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER